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By way of background, it is noted that the Examiner in the current rejection has dropped reliance on Kazama '321 as anticipatory. The rejection proceeds predicated on obviousness using that reference in view of Charvet.

In essence, it is the Applicant's position that there is no prima facie obviousness. The Examiner accurately characterizes the scope of the disclosure of Kazama. The Examiner points out the deficiencies in the scope of that disclosure, namely that there is no breaking torsion value and more importantly, that the reference does not disclose performing the steel wire to a minimum to a radius of curvature. Indeed, it is that last facet of Kazama which the Applicant deems to be crucial and, one which gives rise to the conclusion that there is no prima facie obviousness. That is, while the reference certainly discloses a steel wire having certain attributes, and in fact discloses the use of the steel wire for use in a radial tire, there is neither teaching nor suggestion that the wire should have any perform associated with it.

The Examiner's reliance on Charvet is correct to a point. The reference does have applicability to tires as the Examiner references and does provide an example of a steel wire performed to a radius of curvature, albeit the intermediate layer 2 for a completely different reason, but most importantly, the reference itself discloses and deals with a wire cord construction, which is fundamentally at odds with Kazama. That is, Charvet is directed exclusively to a cord structure employing three layers having a particular relationship of diameters and twisting pitches. The steel wire of Kazama is a drawn steel wire, which is twisted using a bunching type technique, one which produces results materially different from the multi layer twisted construction of Charvet.

Consequently, the artisan would in the first insistence clearly recognize this clear difference in cord construction between the two references. In Charvet, the need to have an internal radius of curvature in the intermediate layer is a function of the overall three layer construction. That need or requirement does not in anyway exist in Kazama et al.

Stated differently, if the teaching of Charvet were to be considered of interest, which layer in Kazama would be considered analogous to or equivalent to the intermediate layer 2 of Charvet? It is that layer, which the reference provides for a radius of curvature for the purpose of having the cords distributed uniformly around the core layer 1. In that regard, the question would be asked by the artisan, which of the wires in any of the embodiments of Kazama constitutes the core? Whether it be the three wire constructions illustrated in Figures 7 and 8 or the 4 and 5 wire constructions of Figures 9A and 9B, Kazama does not define the twisted cord construction having discreet core, intermediate layer, and sheath as does Charvet. Thus, the requirement to have a predetermined radius of curvature in the intermediate layer does not exist and an artisan would clearly recognize that this difference in wire constructions would provide no motivation or requirement to make the substitution the Examiner deems to be obvious.

Thus, it is believed that factually there is no prima facie obviousness for the Examiner's contention that it would have been obvious to ~~perform the~~ preform steel wires of Kazama to any radius of curvature and certainly not one to allow for each plane to perpendicular to the axis. That latter holding is plainly contrary to the scope and teaching of the reference as a whole because the wire construction of Kazama does not allow for the planes to be perpendicular to the axis in a twisting direction as in the case of Charvet. The Examiner should note for example 8b, 8c, and 8d. The

holding is simply contrary to the plane teachings of Kazama. Secondly, the Examiner's holding is contrary to applicable law. It is believed that a rejection such as this, which attempts to combined two prior art references has been subject to a high degree of development within established precedent. Simply taking the teachings of two references and providing for a conclusion does not satisfy the Examiner's burden of proof or, set forth prima facie case of obviousness as an issue of a fact when considered by the relevant contemporary decisions.

There must be some showing of the obviousness of the claim as a whole, not the discrete parts to establish prima facie obviousness. When the art in question, as is the case here, is straight forward, the opportunity to judge by hindsight is particularly tempting. Consequently, the tests of whether to combine references need to be applied rigorously. *See: In re Dembiczak*, 175 F.3d 994, 999, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999), *limited on other grounds by In re Gartside*, 203 F.3d 1305, 53 USPQ2d 1769 (2000). The same principle applies here because Examiner's analysis is backward to achieve the end point already defined - the claims under examination. The first, is that prima facie obviousness is a legal requirement and the burden is on the Examiner to demonstrate using only objective evidence or suggestion from the applied prior art, that one of ordinary skill would have been lead to the claimed invention as a whole without recourse to Appellant's disclosure. See: *In re Oetiker*, 977 F.2d1443, 1447-48, 24USPQ2d 1443, 1446-47(Fed.Cir.1992); *In re Fine* 837 F.2d1071, 1074-75, 5USPQ2d 1596, 1598-1600(Fed.Cir.1988). As a matter of law then, it is the burden of the Examiner to demonstrate that the prior art, and not Appellant's disclosure, would lead the hypothetical artisan to the claimed invention as a whole. What the Examiner has done, and as plainly apparent in the

statement of rejection, is to dissect the claim into discreet components and then to apply individual pieces of prior art. That is the hallmark of hindsight and not the characteristic of obviousness.

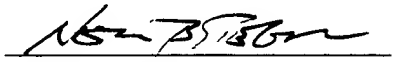
Consequently, it is believed that the Examiner's rejection to claims 1-4 fails as not finding a basis in either law or fact. The same is true with respect to the rejection of claims 1-4. The Examiner's rejection there apparently misconstrues the statement on page 8 of the remarks as some type of an admission relative to the prior art. More appropriately, the comment there was one which pointed out that the radius of curvature when used in steel cord technology for this invention would be considered very severe when compared to a more generalized application the same radius of curvature for rubber reinforcement articles in general. There was no concession that in fact such had been done in the past either relative to tire technology or within conventional steel cord technology. Rather, the statement was that if such were applied to conventional steel cord technology, the expected result would be a deterioration of the wire. The Examiner thus has misconstrued Applicant's comments as rising to the level of an admission of prior art when in fact none is present.

The Applicant thus respectfully contends that in addition to the allowability of claims 5-12, claims 1-4 should now be considered allowable.

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited. Should the Examiner have any questions, he is requested to contact the undersigned attorney of record at the local exchange listed below.

The USPTO is directed and authorized to charge all required fees, except for the Issue Fee and the Publication Fee, to Deposit Account No. 19-4880. Please also credit any overpayments to said Deposit Account.

Respectfully submitted,



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